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09/687,794	10/12/2000	Matthew Parrish	10002096-1	8526

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EXAMINER

DUONG, OANH L

ART UNIT PAPER NUMBER

2155

10

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,794

Applicant(s)

PARRISH ET AL.

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-27, 29-39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 28 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-21 have been cancelled.

Claims 22-42 have been presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/13/2004 has been entered.

#### ***Allowable Subject Matter***

2. Claims 28 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 29 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the user" in line 13.

Claim 29 recites the limitation "the command" in line 27.

Claim 42 recites the limitation "the user" in line 6.

There are insufficient antecedent basis for those limitations in the claims.

### ***Response to Arguments***

4. Applicant's arguments filed on 01/13/2003 have been fully considered but they are not persuasive.

In the remark, applicants argue particularly on independent claim 22 that the teachings of Kirsch is contrast to what is claimed by the applicants such as "the web page sent to the web user's computer by the web tool includes the content to be displayed to the web user, as well as the user information. Examiner respectfully disagrees because the teaching of Kirsch is not contrast to what is claimed by the applicant at all. For example, Kirsch teaches the web page sent to the web user's computer by the web tool includes the content to be displayed to the web user (a web page served by HTTPd server system to client embeds a URL (col. 7 lines 10-12), as well as the user information (the information (i.e., client or account identifier) stored in the embedded URL first served with the web page to the client system 12, seen in col. 7 lines 17-20).

Also in independent claim 22, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a BIT URL specially causes an error message to be generated") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the remarks, applicants argue particularly on independent claim 30 that Kirsch does not teach or suggest that the web page to be displayed to the user is transmitted to the user not only includes the user information to be stored but also the content to be displayed to the web user. Examiner respectfully disagrees because Kirsch does teach this feature. For example, Kirsh teaches the web page to be displayed to the user is transmitted to the user (a web page served by HTTPd server system to client embeds a URL (col. 7 lines 10-12) not only includes the user information to be stored but also the content to be displayed to the web user (the information (i.e., client or account identifier) stored in the embedded URL first served with the web page to the client system 12, seen in col. 7 lines 17-20).

Also in respect to independent claim 30, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of Broken Image Tracking tags or BIT URL, as no "error message" is generated ") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicants' argument particular on independent claim 42, the same response as applied to claims 22 and 30.

In the remarks, Applicant's arguments with respect to claim 26-27, 31, 32, 34 and 39, 41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 22-25, 29-30, 36-38 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by (Kirsch) (US 6,466,966 B1).

Regarding claim 22, Kirsch teaches a method for tracking the use of a web tool by a web user (e.g., see col. 5 lines 8-27), comprising providing a web user through a web user computer access to a web tool (search engine) (e.g., see col. 1 lines 52-56); in response to the user accessing the web tool, inserting (embedding) within at least one or more web page files (web pages) a Broken Image Tracking (BIT) tag (read as a HTML image tag) that includes user information (read as client or account identifier, NwPg) associated with the web user's use of the web tool and a BIT URL designating a server (HTTPd server system 16, col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40); transmitting from the user web tool to the web user computer one or more web page files in connection with the user accessing the web tool (a web page served by an HTTPd server 16 to client 12, col. 1 lines 56-64 and col. 7 lines 10-13); wherein the one or more web page files are configured to be displayed to the user (a web page must be displayed to client browser before client can select an embedded link in the web page, col. 1 lines 51-59 and col. 7 lines 14-17), and the one or more web page files and the BIT tag are configured to be executed by the user computer (web page is served, and click/select of the embedded link in the web page, col. 7 lines 6-23 and col. 8 lines 19-40), the user information is transmitted from the user computer directly to the designated server (col. 5 lines 23-27 and col. 16 lines 17-25); and storing the user information in a database (the persistent mass storage device 32) identified by the designated server (col. 11 line 4-45 and col. 12 lines 32-33).

Regarding claims 23, Kirsch teaches mark up language image tag (e.g., see col. 12 lines 5-15 and col. 8 lines 19-40).

Regarding claim 24, Kirsch teaches the user information embedded in the BIT URL (col. 16 lines 18-20).

Regarding claim 25, Kirsch teaches web tool is provided to a plurality of web users with each user receiving at least one web page including a BIT tag (HTML image tag) with embedded user information (account identifier), wherein the user information for each user is transmitted to the designated server (HTTPd server, abstract, col. 7 lines 6-23 and col. 8 lines 19-40).

Regarding claim 29, Kirsch teaches inserting the BIT tag in the at least one web page file so that it causes substantially no error graphic to be displayed to the user in response to an image file designated with the command not being retrieved (col. 7 lines 6-23).

Regarding claim 30, Kirsch teaches a system for tracking web users' use of a web tool, comprising a web tool server configured to be operatively connected to one or more web user computers (fig. 1), the web tool server including a web tool program configured to provide to each web user computer one or more web page files in a web tool session (col. 1 lines 51-64), the web tool server configured to insert within at least one of the web page files associated with the session a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40), and wherein the web tool is configured to provide the at least one web page to the web user computer to be displayed by the web user computer (col. 1 lines 51-64); and the at least one web page and the BIT tag are configured to be executed by the web user computer after the



web page have been received by the user computer (col. 7 lines 10-23); and a designated server identified in the BIT URL and configured to be operably connected to the one or more web user computers (col. 8 lines 31-45), wherein the web page file and the BIT tag, when executed by the web user computer, cause the web user computer to transmit to the designated server the user information (col. 7 lines 10-17 and col. 20 lines 15 lines 17-25), and further wherein the designated server is configured to store the user information (col. 11 lines 4-9).

Regarding claim 36, Kirsch teaches the BIT tag is implemented with a mark-up language tag (col. 12 lines 5-15 and col. 8 lines 19-40).

Regarding claim 37, Kirsch teaches an HTML image tag (col. 12 lines 5-15).

Regarding claim 38, Kirsch teaches the Web tool server (HTTPd server) and designated server (designated tracking HTTPd server system) are implemented in the same server (server system 16, seen in col. 6 lines 53-60).

Regarding claim 42, Kirsch teaches a computer program product for tracking the use of a web tool by a web user (e.g., see col. 5 lines 8-27), the product comprising computer readable instructions thereon that when executed cause a computer to perform the following acts providing a web user through a web user computer access to a web tool (e.g., see col. 1 lines 52-56); in response to the user accessing the web tool, inserting within at least one or more web page files, using the web tool, a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40); transmitting from the user web wool to the web user computer one or more web page

files (e.g., see col. 1 lines 56-64); and wherein upon receipt of the web page file by the web user computer, the one or more the one or more web page files are configured to be displayed to the user (col. 1 lines 51-59), and the one or more web page files and the BIT tag are configured to be executed by the user computer upon receipt of the web page file by the web user computer (abstract, col. 7 lines 6-23 and col. 8 lines 19-40); the web page file is configured such that, upon execution of the web page file and the BIT tag by the web user computer, the BIT URL is transmitted to a designated server (col. 7 line 51-col. 8 line 2 and col. 8 lines 19-22); and the BIT URL is configured such that, in response to the BIT URL being processed by the designated server (col. 16 lines 23-25), the user information is stored in a database (col. 11 line 4-45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-27, 31-35, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch in view of Jennings, III et al. (Jennings) (US 2003/0220998 A1).

Regarding claims 26 and 27, Kirsch does not explicitly teach the user information is stored in an error log as claimed. However, Jennings, in the same field of endeavor, teaches the user information is stored in an error log within the designated server

(server's log file include: the client's network address, the file being requested...error, in page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 31, Kirsch does not explicitly teach an error log. However, Jennings, in the same field of endeavor, teaches an error log/log file (server's log file, page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 32, Kirsch teaches implement the designated server as a web server (HTTPd server 30, in fig. 2). Kirsch does not teach an error log. Jennings, in the same field of endeavor, teaches Internet programs stores user information from the request into the error log in response to an error being generated by the request at the designated server (server's log file include: the client's network address, the file being requested...error, in page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at

the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 33, Kirsch/Jennings teaches the BIT URL designates a broken image file (Kirsch, col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40); file that cannot be found within the designated server, which causes the error to be generated by the Internet program (Jennings, in page 2 paragraph 27).

Regarding claim 34, Kirsch/Jennings teaches a web server with an error log (Jennings, in page 2 paragraph 27), the user information is stored in the database separate from the error log (Kirsch, storage 32, in fig. 2, col. 11 lines 39-45).

Regarding claim 35, Kirsch/Jennings teaches storing user information in database (Kirsch, col. 11 lines 39-45).

Regarding claim 39, Kirsch teaches a web tool system having a capacity of tracking a users' use of a web tool, comprising a web tool server communicatively linked to a web user computer for providing a web user with access to a web tool (fig. 1), the web tool server including a web tool program configured generate and provide to the web user computer one or more web page files in connection with the web user engaging in a session the web tool (col. 1 lines 51-64), the web tool server further being configured to include in the one of the web page files a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40), and wherein the at least one web page file and the BIT tag are configured to be executed by the user computer after the web page has been received by the web user computer (col. 7 lines

10-23); and the at least one web page file is configured to be displayed by the web user computer (col. 1 lines 51-64); and designated server identified in the BIT URL and communicatively linked to the web user computer (col. 8 lines 31-45); a user information database server communicatively linked to the designated server, wherein the designated server is configured to transfer the user information from the BIT URL to the user information database in response to processing the BIT URL (col. 11 lines 5-9). Kirsch does not explicitly teach an error log. Jennings, in the same field of endeavor, teaches the designated server including a web server with an error log (page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 41, Kirsch teaches BIT URL (HTML image tag) causes the designated server to generate a broken image file designation (read as image file, i.e., MTCH1073.gif, in col. 12 lines 14-15).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D  
February 27, 2004

  
**HOSAIN ALAM**  
SUPERVISORY PATENT EXAMINER